



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/037,916 03/10/98 NISHIO

N P8287-8002

EXAMINER

TM02/0802

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
1050 CONNECTICUT AVENUE, N.W., SUITE 600
WASHINGTON DC 20036-5339

SMITH, H

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

08/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/037,916

Applicant(s)

Nishio et al.

Examiner

Huyng S. Sough

Art Unit

2161



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 16 May 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit: 2161

Information Disclosure Statement

1. The information disclosure statement filed on May 16, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. More specifically, substantial number of pages are missing from the cited foreign patents. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 16, 2001 have been approved by the Examiner.

Specification

3. The disclosure is objected to because of the following informalities: .

- Page 57, line 23, should "display 402" be --display 502--?
- Page 65, line 1, "first purse area 106A (step C327)", is contradicting to the FIG. 32.

More specifically, in FIG. 32, "step C327" does not have "first purse area".

Applicant is advised to carefully review the entire specification for further needed corrections.

Art Unit: 2161

Claim Rejections - 35 U.S.C. § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 13, line 18, it is not clear whether “said terminal” is referring to “each terminal” of “a first terminal group”, “each terminal” of “a second terminal group” or “each terminal” of both terminal groups.

Line 23, “said second terminal” does not have proper antecedent basis.

Should this be --said second terminal group--?

- Claim 14, line 10, it is not clear whether “a second ciphering unit” is the same as “a second ciphering/deciphering unit” recited in line 6 or not.

Lines 15-16, “the terminals” does not have proper antecedent basis.

Line 16, “said second terminal” does not have proper antecedent basis.

Line 17, “said first group” does not have proper antecedent basis.

Line 19-20, “the first and second ciphering/deciphering units” does not have proper antecedent basis.

Applicant is advised to carefully review all the claims for further needed corrections.

Art Unit: 2161

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Read (EFTPOS: electronic funds transfer at point of sale: ELECTRONICS & COMMUNICATION ENGINEERING JOURNAL NOVEMBER/DECEMBER 1989, pp 263-270) in view of Harrop (New electronics for payment: IEE REVIEW OCTOBER 1989, pp 339-342) and Schuler et al. (Schuler hereinafter: WO 90/15382)

Re claim 13, Read discloses an electronic purse system having all of the features claimed except for the explicit disclosure of (a) the second terminal group which does not perform ciphering/deciphering of the information related to money and (b) the claimed access control program: *a first terminal group (i.e., ATM) which can transfer money to an IC card; wherein each terminal in the first group includes a first ciphering/deciphering unit (i.e., encryption/decryption system); (2) a second terminal group (i.e., telephone); and an IC card including a first purse (i.e., a secret level), a second level (i.e., a free level), and a second ciphering/deciphering unit (i.e., encryption/decryption system) for the first purse.* However, as shown by Harrop, it is well known in the art to use a prepayment card for payphones and the

Art Unit: 2161

prepayment card does not perform ciphering and deciphering of the information related to money. Thus, it would have been obvious to one of ordinary skill in the art to modify the electronic purse system of Read by adopting the teaching of Harrop (i.e., by replacing the second level of Read with the prepayment phone card of Harrop) to facilitate the use of the smart card by eliminating ciphering/deciphering steps for a transaction which does not require high security. Further, the electronic purse system of Read modified by Harrop would inherently work as claimed, i.e., performing cipher/decipher the information for the transaction between the first terminal group and IC card and without performing cipher/decipher the information for the transaction between the second terminal group and IC card. Still further, Schuler discloses the use of an access control program (i.e., *Access control*) including a first purse access program (i.e., *Access application zone*), a second purse access program (i.e., *Unprotected zones*), and a selecting step program (e.g., to access one of two zones, there should be a selecting step based on the information provided to IC card), wherein the first purse access program (i.e., *Access application zone*) can access both the first and second purse to transfer money from the first purse to the second purse but a second terminal group cannot access to the first access program to minimize the loss of the fund. Thus, it would have been within the level of ordinary skill in the art to modify the electronic purse system of Read by adopting the teachings of Schuler to facilitate the use of the smart and to minimize the loss of the fund when the card is lost or stolen.

Re claims 14-19, Read discloses an IC card having all of the features claimed except for the explicit disclosure of (a) making a payment from the second purse without performing

Art Unit: 2161

ciphering/deciphering of the information related to money and (b) the claimed access control program: *an IC card including a first purse (i.e., a secret level) having a first ciphering/deciphering means (i.e., encryption/decryption system) and a second level (i.e., a free level) and a second level (i.e., a free level)*. However, as shown by Harrop, it is well known in the art to use a prepayment card for various terminals (i.e., payphones, vending machines and ticket machines) and the prepayment card does not perform ciphering and deciphering of the information related to money. Thus, it would have been obvious to one of ordinary skill in the art to modify the IC card of Read by adopting the teaching of Harrop (i.e., by replacing the second level of Read with the prepayment card of Harrop) to facilitate the use of the smart card by eliminating ciphering/deciphering steps for a transaction which does not require high security. Further, the IC card of Read modified by Harrop would inherently work as claimed, i.e., performing cipher/decipher the information for the transaction between the first terminal group and IC card and without performing cipher/decipher the information for the transaction between the second terminal group and IC card. Still further, a recitation of the intended use of the claimed invention (e.g., "for storing a first amount of money") must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (e.g., EEPROM used for making the IC card of Read), then it meets the claim. Still further, Schuler discloses the use of an access control program (i.e., *Access control*) including a first purse access program (i.e., *Access application zone*), a second purse access program (i.e., *Unprotected*

Art Unit: 2161

zone), and a selecting step program (e.g., to access one of two zones, there should be a selecting step based on the information provided to IC card), wherein the first purse access program (*i.e.*, *Access application zone*) can access both the first and second purse to transfer money from the first purse to the second purse but a second terminal group cannot access to the first access program to minimize the loss of the fund. Thus, it would have been within the level of ordinary skill in the art to modify the electronic purse system of Read by adopting the teachings of Schuler to facilitate the use of the smart and to minimize the loss of the fund when the card is lost or stolen.

Response to Arguments

8. Applicant's arguments with respect to claims 13-19 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

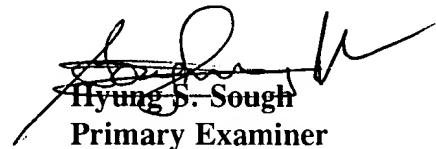
Art Unit: 2161

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax number is (703) 308-1396.


Hyung S. Sough
Primary Examiner
Art Unit 2161

shs
July 29, 2001